

### **REMARKS**

Claims 40, 49, and 57 have been amended, and new dependent claims 85-89 have been added. Support for the amendments can be found, for example, in canceled claim 48, and paragraphs [0007] and [0009] of the published application (2005/0014652). Claims 40-47, 49-62 and 85-89, of which claim 40 is the sole independent claim, are pending.

#### **Claim Rejection – 35 U.S.C. § 103**

Claims 40-47 and 49-62 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over by the sole lost count of Patent Interference No. 105,406 in view of U.S. Patent Application No. 2002/0056401 ("Rupich"). As amended, the claims recite a method of producing an oriented oxide superconducting film, wherein the oriented oxide superconducting film exhibits c-axis texturing. Neither the lost count nor Rupich discloses or suggests a method of producing an oriented oxide superconducting film that exhibits c-axis texturing. Thus, assuming, but not conceding, that the lost count and Rupich could have been properly combined, the resulting combination could not have arrived at the claimed subject matter. Additionally, since neither the lost count nor Rupich recognizes the desirability of having c-axis texturing (which can improve the performance (e.g., current density) of the superconducting film), there is no reason or motivation to modify the lost count or Rupich to provide c-axis texturing. Applicants request that the rejection be withdrawn.

The newly added dependent claims 85-89 are patentable for at least the same reasons that claim 40 is patentable.

For at least the reasons discussed above, the claims are in condition for allowance, which action is requested.

No fee is believed to be due, but please apply any charges or credits to deposit account 03-1721, referencing Attorney Docket No. 0492611-0545/MIT9277CON2.

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Respectfully submitted,

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